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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,080	11/27/2000	Ulrich Hetzer	P00,1839	4251

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SCHIFF HARDIN, LLP  
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EXAMINER

HAMILTON, LALITA M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/723,080

Applicant(s)

HETZER ET AL.

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on RCE filed on September 17, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Request for Continued Examination (RCE)

The RCE filed on September 17, 2004 has been processed. A new action follows below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-18, 20, 22, and 25-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsushita (5,132,729) in view of Storch (5,367,148) and French (EP 0825564 A2).

Matsushita discloses the invention substantially as claimed; however, Matsushita does not disclose generating a code number range, containing a plurality of code numbers, and allocating said code number range to said device identification number; generating a reference code number range, containing a plurality of reference code

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numbers respectively having relationships to the respective code numbers in said code number range; conducting the step at a manufacturer of said replacement consumable and aggregating said code number in said code number range with said replacement consumable during manufacture of said replacement consumable; consuming one of the reference code numbers in the device by striking one of the reference code numbers from the device; upon receipt of said indication at said remote data center, producing a chip card having a new group of reference code numbers stored therein, physically transporting said chip card to said device, and inserting said chip card into a chip card reader at said device to load said new group of reference code numbers into said device; a printing device having an ink jet print head with an integrated ink tank containing ink, said ink comprising said consumable; the device is a postage meter machine having a printer which produces a plurality of franking imprints, thereby consuming said consumable, and wherein said microprocessor monitors a number of said franking imprints which occur between each replacement of said consumable, and wherein said microprocessor uses said number of franking imprints as a basis for producing said authentication result; said microprocessor generates a message for display on said display if said authentication result indicates an unauthorized replacement; said device has a chip card reader connected to said microprocessor, said chip card reader receiving a chip card therein, and wherein said microprocessor establishes a communication to a remote location, dependent on said authentication result, upon insertion of said chip card into said chip card reader; said postage meter machine requires periodic credit reloading, and wherein said microprocessor

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establishes a communication to a remote location in conjunction with a credit reloading and reports said authentication result in said communication; or a display connected to said microprocessor, said microprocessor generating a message on said display indicating said need for replacing said consumable or said reference code number range containing a plurality of reference code numbers respectively having relationships to code numbers representing an authorized replacement consumable. Storch teaches a counterfeit detection system comprising generating a code number range, containing a plurality of code numbers, and allocating said code number range to said device identification number (col.14, lines 15-50) and generating a reference code number range, containing a plurality of reference code numbers respectively having relationships to the respective code numbers in said code number range (col.14, lines 15-50). French teaches consuming one of the reference code numbers in the device by striking one of the reference code numbers from the device (col.6, line 25 to col.7, line 15); upon receipt of said indication at said remote data center, producing a chip card having a new group of reference code numbers stored therein, physically transporting said chip card to said device, and inserting said chip card into a chip card reader at said device to load said new group of reference code numbers into said device (col.3, lines 20-42 (removable chip that can be downloaded remotely or locally)); a printing device having an ink jet print head with an integrated ink tank containing ink, said ink comprising said consumable (col.3, lines 20-25 and fig.1: 5); the device is a postage meter machine having a printer which produces a plurality of franking imprints, thereby consuming said consumable, and wherein said microprocessor monitors a number of

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said franking imprints which occur between each replacement of said consumable, and wherein said microprocessor uses said number of franking imprints as a basis for producing said authentication result (col.3, lines 20-56); said microprocessor generates a message for display on said display if said authentication result indicates an unauthorized replacement (col.4, lines 5-15); said device has a chip card reader connected to said microprocessor, said chip card reader receiving a chip card therein, and wherein said microprocessor establishes a communication to a remote location, dependent on said authentication result, upon insertion of said chip card into said chip card reader (col.3, lines 20-42 (removable chip that can be downloaded remotely or locally)); said postage meter machine requires periodic credit reloading, and wherein said microprocessor establishes a communication to a remote location in conjunction with a credit reloading and reports said authentication result in said communication (col.3, lines 30-58); and a display connected to said microprocessor, said microprocessor generating a message on said display indicating said need for replacing said consumable or said reference code number range containing a plurality of reference code numbers respectively having relationships to code numbers representing an authorized replacement consumable (col.5, line 35 to col.6, line 14). It would have been obvious to one having ordinary skill in the art that the time the invention was made to incorporate generating a code number range, containing a plurality of code numbers, and allocating said code number range to said device identification number; generating a reference code number range, containing a plurality of reference code numbers respectively having relationships to the respective code

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numbers in said code number range; conducting the step at a manufacturer of said replacement consumable and aggregating said code number in said code number range with said replacement consumable during manufacture of said replacement consumable; consuming one of the reference code numbers in the device by striking one of the reference code numbers from the device; upon receipt of said indication at said remote data center, producing a chip card having a new group of reference code numbers stored therein, physically transporting said chip card to said device, and inserting said chip card into a chip card reader at said device to load said new group of reference code numbers into said device; a printing device having an ink jet print head with an integrated ink tank containing ink, said ink comprising said consumable; the device is a postage meter machine having a printer which produces a plurality of franking imprints, thereby consuming said consumable, and wherein said microprocessor monitors a number of said franking imprints which occur between each replacement of said consumable, and wherein said microprocessor uses said number of franking imprints as a basis for producing said authentication result; said microprocessor generates a message for display on said display if said authentication result indicates an unauthorized replacement; said device has a chip card reader connected to said microprocessor, said chip card reader receiving a chip card therein, and wherein said microprocessor establishes a communication to a remote location, dependent on said authentication result, upon insertion of said chip card into said chip card reader; said postage meter machine requires periodic credit reloading, and wherein said microprocessor establishes a communication to a remote location in

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conjunction with a credit reloading and reports said authentication result in said communication; or a display connected to said microprocessor, said microprocessor generating a message on said display indicating said need for replacing said consumable or said reference code number range containing a plurality of reference code numbers respectively having relationships to code numbers representing an authorized replacement consumable, as taught by Storch and French into the invention disclosed by Matsushita, to deter possible theft, as an alternative means of storing and transmitting data to the device, and to prevent additional cost from having to send the device back to have a new code numbers stored into the device.

Claims 19, 21, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsushita, Storch, and French as applied to claims 18 and 20 above, and in further view of Philips (WO 98/04414).

Matsushita discloses and Storch and French teach the invention substantially as claimed; however, none of the references disclose nor teach a printing device having an inking ribbon in a cassette, as said consumable, and wherein said sensor comprises an encoder which interacts with said cassette; a printing device having an interchangeable ink tank cassette containing electrically conductive ink as said consumable, and wherein said sensor comprises electrical contacts interacting with said electrically-conductive ink to identify an amount of said electrically conductive ink in said ink tank cassette; a device which consumes a liquid as said consumable, said liquid being packaged in packaging material having an identifier thereon usable as said code number; or a device which consumes a non-solid aggregate state consumable. Philips teaches a printing



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device comprising having an inking ribbon in a cassette, as said consumable, and wherein said sensor comprises an encoder which interacts with said cassette (p.3, lines 18-24 and fig.1: 6); a printing device having an interchangeable ink tank cassette containing electrically conductive ink as said consumable, and wherein said sensor comprises electrical contacts interacting with said electrically-conductive ink to identify an amount of said electrically conductive ink in said ink tank cassette (p.3, lines 30-33 and p.5, lines 1-15); a device which consumes a liquid as said consumable, said liquid being packaged in packaging material having an identifier thereon usable as said code number (p.4, line 23 to p.5, line 15); and a device which consumes a non-solid aggregate state consumable (p.4, line 23 to p.5, line 15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a printing device having an inking ribbon in a cassette, as said consumable, and wherein said sensor comprises an encoder which interacts with said cassette; a printing device having an interchangeable ink tank cassette containing electrically conductive ink as said consumable, and wherein said sensor comprises electrical contacts interacting with said electrically-conductive ink to identify an amount of said electrically conductive ink in said ink tank cassette; a device which consumes a liquid as said consumable, said liquid being packaged in packaging material having an identifier thereon usable as said code number; and a device which consumes a non-solid aggregate state consumable, as taught by Philips into the device and method disclosed by Matsushita and taught by Storch and French, to provide the device with a means of leaving a permanent coded imprint on a device.

***Response to Arguments***

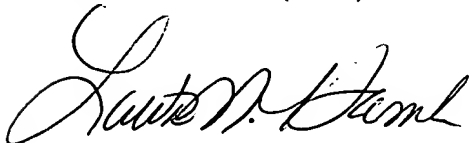
Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Lalita M. Hamilton', is written in a cursive style.

LMH